

REMARKS

In the final Office Action, the Examiner rejected claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,404,393 to Remillard ("*Remillard '393*") in view of U.S. Patent No. 5,404,393 to Bull et al. ("*Bull*"). *Remillard '393* incorporates U.S. Patent Application No. 7/770,520 to Remillard (now U.S. Patent No. 5,396,546) by reference ("*Remillard '546*").

By this amendment, Applicants amend claims 1 and 9, and add new claims 17-26.

Applicants respectfully traverse the rejection of claims 1 and 9 under 35 U.S.C. § 103(a).

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the

claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) . . . The factual inquiry . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, for example, recites a server operational expenses collecting method. The method comprises, among other things, "reorganizing a first electronic program guide into a second electronic programming guide tailored to the first viewer, the reorganizing being done in accordance with the first viewer tendency information."

Remillard '393 discloses "[a]n electronic device and method for accessing remote electronic facilities and displaying associated information on a conventional television set," and programming information can be downloaded to the electronic device (*Remillard '393*, abstract). *Remillard '393* also discloses a controller that initiates a data

call to a computer system to acquire configuration information, and the configuration information controls which menu choices a viewer may select (*Remillard* '393, col. 2, lines 44-62).

Remillard '546 discloses a card reader that permits a viewer to purchase pay-per-view programming (*Remillard* '546, col. 3, lines 20-25). Applicants understand the Examiner's position to be that, as *Remillard* '393 discloses configuring menu choices based on configuration information, and *Remillard* '393 discloses pay-per-view programming, the references can be read as disclosing configuring a menu of television programming (See Office Action at p. 5, stating "a menu listing options from which a user can select pay-per-view programming to view is a programming guide.")

Even assuming the Examiner is correct (a position Applicants do not concede), claim 1 recites reorganizing based on "first viewer tendency information indicating the first viewer's tendency to view programs" (emphasis added). In contrast, *Remillard* '393 and '546 rely on viewers directly "select[ing] desired services from among several services displayed in menu" (*Remillard* '546, col. 3, lines 54-56).

Further, the claimed "first viewer tendency information" is generated "on the basis of a program viewing log," whereas *Remillard* '393 and '546 rely on users entering their desired services "by operation of a remote keypad" (*Remillard* '546, col. 3, lines 55-56). Therefore, neither *Remillard* '393 or *Remillard* '546 teaches or suggests the claimed "reorganizing a first electronic program guide into a second electronic programming guide tailored to the first viewer, the reorganizing being done in accordance with the first viewer tendency information," as recited by independent claim 1.

Bull fails to cure the deficiencies of *Remillard '546* and *Remillard '393*. *Bull* discloses an information aggregation and synthesization system and process (*Bull*, abstract). However, *Bull* does not disclose reorganizing program guides. Therefore, *Bull* fails to teach or suggest "reorganizing a first electronic program guide into a second electronic programming guide tailored to the first viewer, the reorganizing being done in accordance with the first viewer tendency information," as recited by independent claim 1.

Although of different scope, independent claim 9 is distinguishable over *Remillard '546*, *Remillard '393*, and *Bull* for at least the same reasons as claim 1. Because the cited references fail to teach or suggest each and every element recited by claims 1 and 9, no prima facie case of obviousness has been established with respect to these claims. Applicants therefore request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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